

Remarks

Claims 1-25 are pending in the present application. Claim 1-25 are rejected under 35 U.S.C. §102(b) as being anticipated by Hertl et al. (U.S. Patent No. 5,417,947). Claims 1-25 are also rejected under 35 U.S.C. §103(a) as being unpatentable over Hertl in view of Minami et al. (U.S. Patent No. 5,140811.)

a. Rejection Under 35 U.S.C. §102(b) and Under 35 U.S.C. §103(a)

Claim 1-25 are rejected under 35 U.S.C. §102(b) as being anticipated by Hertl et al. (U.S. Patent No. 5,417,947).

Applicants would like to point out to the Examiner several relevant cases which hold that an invention may be patentable even when it discloses a composition with ranges that overlap with the prior art. Each case is attached for the Examiner's convenience. For example, *Ex parte Shelby* holds:

The only factor which remains to be considered is that of proportions of the several components. Here it must be acknowledged that the percentages of the appealed claims fall within the general proportions of the reference, namely, 25-90 parts, preferably 50-85 parts of methyl methacrylate; 10-60 parts of 2-ethylhexyl acrylate; and 1-10 parts, preferably 2-7 parts of methacrylic acid. However, **this does not completely preclude the granting of a specific patent within the general percentage ranges of the reference.**

Ex parte Shelby, 153 U.S.P.Q. 476 (1966) (emphasis added)

Similarly, *Becket v COE*, Commissioner of Patents also holds an invention may be patentable even though the ranges overlap with the prior art:

In short, **within previously claimed ranges Becket has found more restricted ones** which produce a different alloy from that known to the prior inventors. One seeking a stainless deep-drawing alloy and finding the Hadfield (French) and Commentry (French) patents could not have said: 'These give me what i want. In the light of the decisions above cited as to the effect of foreign patents as anticipations, **neither of the foreign references anticipated Becket.**

Becket v COE, Commissioner of Patents, 69 App.D.C. 51, 98 F.2d 332 (1937) (emphasis added)

As part of the Examiner's argument for rejecting the present application, the Examiner points out as proof of unpatentability (either under 102 or 103) that Hertl gives an example with a Si to Al ratio which overlaps the present invention. The present invention expresses the range for the Si to Al ratio (claims 1 and 14) as "a sufficiently low Si to Al atom ratio that less than about 50% of the low molecular weight hydrocarbons desorb from the hydrocarbon-removing material at a temperature of about 250°C." The Applicants have explained the criticality of the Si to Al ratio in their March 12, 2004 Amendment under 37 C.F.R. § 1.116. Specifically, the Si to Al ratio as expressed in independent claims 1 and 14 is necessary to tailor the operation of the tandem water-removing composition and hydrocarbon-removing material of the present application such that significant desorption of the low molecular weight hydrocarbons does not occur until a sufficiently high temperature at which a catalytic converter may remove such hydrocarbons is achieved. Accordingly, in view of the relevant case law as set forth above, independent claims 1 and 14 and their respective dependent claims are allowable even though the present invention may overlap with the prior art.

Conclusion

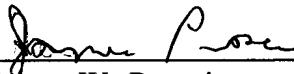
Applicants have made a genuine effort to respond to each of the Examiner's rejections in advancing the prosecution of this case. Applicants believe that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested. If a telephone or video conference would

help expedite allowance or resolve any additional questions, such a conference is invited at the Examiner's convenience.

Applicants believe that no additional fees are required as a result of the filing of this paper. However, the Examiner is authorized to charge any additional fees or credits as a result of the filing of this paper to Ford Global Technologies, Inc.'s Deposit Account No. 06-1510 as authorized by the original transmittal letter in this case. If a telephone or video conference would help expedite allowance or resolve any additional questions, such a conference is invited at the Examiner's convenience.

Respectfully submitted,

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By 
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Date: April 15, 2004

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Attachments

98 F.2d 332
35 U.S.P.Q. 150

(Cite as: 69 App.D.C. 51, 98 F.2d 332)

► United States Court of Appeals for the District of Columbia.

BECKET.
v.
COE, Commissioner of Patents.
No. 6790.

Decided Sept. 27, 1937.
On Rehearing June 6, 1938.

Appeal from the District Court of the United States for the District of Columbia.

Suit by Frederic M. Becket against Conway P. Coe, Commissioner of Patents, for a decree directing defendant to allow certain claims of an application for letters patent. From a decree of dismissal, plaintiff appeals.

Reversed in part and affirmed in part.

West Headnotes

[1] Patents 66(1.3)
291k66(1.3) Most Cited Cases
(Formerly 291k66(1))

Foreign patents are valid references when there is a clear disclosure of the invention sought to be patented in the United States, but where such a patent merely prophesies what can be done without setting forth that it has been done, or makes claims for things not fairly disclosed in the specification, the foreign patent does not anticipate.

[2] Patents 65
291k65 Most Cited Cases

A patent relied on as an anticipation must itself speak, and its specification must give in substance the same knowledge and the same directions as the specification of the patent in suit, and it is not enough to prove that a method or apparatus described in an earlier specification can be made to produce a particular result.

[3] Patents 66(1.21)
291k66(1.21) Most Cited Cases
(Formerly 291k66(1))

Certain claims of an application for a patent relating to a stainresisting iron-base alloy having deep-drawing properties were not anticipated by foreign references and were improperly rejected by Patent Office tribunals for lack of invention over references.

[4] Patents 7.6

Page 1

291k7.6 Most Cited Cases
(Formerly 291k7)

Patentability of an alloy on the basis of new proportions of old elements requires that the new proportions give a new result, either a new alloy or an old alloy with new characteristics resulting in entirely new, or substantially enhanced, qualities of utility.

[5] Patents 109
291k109 Most Cited Cases

An added claim to an application for a patent relating to a stainresisting iron-base alloy having deep-drawing properties was properly rejected by Patent Office tribunals as not warranted by original disclosure.

**332 *51 Ralph E. Parker and Richard L. Scheffler, both of Washington, D.C., and Warren J. Willis, Eugene L. Greenewald, and Donald C. Harrison, all of New York City, for appellant.

R. F. Whitehead, Solicitor, U.S. Patent Office, of Washington, D.C., for appellee.

Before MARTIN, Chief Justice, and ROBB, VANORSDEL, GRONER, and STEPHENS, Associate Justices.

PER CURIAM.

The decree of the District Court of the United States for the District of Columbia in this cause is affirmed by an equally divided court.

Mr. Justice VANORSDEL sat during the argument of this case but died August 7, 1937.

On Rehearing.

Before GRONER, Chief Justice, and STEPHENS and MILLER, Associate Justices.

STEPHENS, Associate Justice.

This is an appeal from a decree of the District Court of the United States for the District of Columbia, which dismissed a bill brought under Revised Statutes, Section 4915, 35 U.S.C. § 63, 35 U.S.C.A. § 63, seeking *52 **333 a decree directing the Commissioner of Patents to allow certain claims of an application for letters patent.

Becket, the appellant, filed an application in the Patent Office, setting forth claims for a stain-resisting iron-base alloy having deep-drawing properties. The Examiner rejected claims 9, 10 and 11 on the ground that they showed

(Cite as: 69 App.D.C. 51, 98 F.2d 332)

no invention over the references: Greaves (British) 117,286; Hadfield (British) 313,471; Hadfield (French). The appellant thereupon brought his original bill in this suit his original bill in this suit. Thereafter the Patent Office granted Patent No. 1,962,702 to Percy A. E. Armstrong for a corrosion-resistant ferrous alloy. The appellant, apparently claiming that Armstrong's alloy and his were substantially the same, copied Armstrong's claim 6 and added it to his application as claim 12. The Examiner rejected this claim upon the ground that it was not warranted by the original disclosure, and his decision was affirmed by the Board of Appeals. The appellant thereupon filed a supplemental bill of complaint in the District Court, adding his claim 12 to his action. The court dismissed the bill as to claims 9-12, inclusive.

The appellant's original claims involved herein are as follows:

'9. A stain-resisting iron-base alloy having deep-drawing properties and comprising from about 16% to about 22% of chromium; about 0.25% to about 2.75% of copper; carbon, the carbon content being not more than about 0.3%; at least about 3% of manganese and at least about 2% of nickel, the sum of the manganese and nickel percentages falling between about 6% and about 14%; the balance of the alloy being substantially iron.

'10. A stain-resisting iron-base alloy having deep-drawing properties and comprising from about 16% to about 22% of chromium; about 0.25% to about 2.5% of copper; carbon, the carbon content being not more than about 0.12%; at least about 3% of manganese and at least about 2% of nickel, the sum of the manganese and nickel percentages falling between about 8% and about 14%; the balance of the alloy being substantially iron.

'11. A stain-resisting iron-base alloy having deep-drawing properties and comprising from about 16% to about 22% of chromium; about 0.25% to about 2.5% copper; carbon, the carbon content being not more than about 0.12%; at least about 5.3% of manganese and at least about 2% of nickel, the sum of the manganese and nickel percentages falling between about 8% and about 14%; the balance of the alloy being substantially iron.'

The specification showed the composition of several examples which the appellant had worked out within the claimed ranges of proportions. Such of the examples as contained copper showed a chromium content varying between 17.75% and 22.17%, copper content varying between 1.02% and 1.39%, carbon content between 5.3% and 6.54%, and nickel content between 2.22% and 5.75%. Another specific example, containing copper but outside the range for chromium, had 12.54% chromium, .64% copper, .12% carbon, 6.12% manganese, and 6.29% nickel.

The Hadfield (French) patent claimed primarily a corrosion resistant alloy which had properties of resistance of oxidization and sealing at high temperatures and of high tensile and compression strength at both ordinary and high temperatures. The specification stated:

'For this purpose, an alloy according to the invention contains, in addition to iron, carbon up to about 1%, manganese up to about 8%, and from about 5% to about 25% of chromium, from about 5% to about 20% of nickel and from about 1% to about 10% of silicon with, it may be, either from 1% to 10% of tungsten (or of its equivalent molybdenum), or up to about 6% of copper, or both of these elements together.'

The ranges of elements in the first claim were carbon up to about 1%, manganese up to about 8%, chromium from 5% to 25%, nickel from about 5% to about 20%, and silicon from about .5% to about 10%. After stating these percentages the claim continued: ' . . . these alloys being about also to contain either from about 1% to about 10% of tungsten (or its equivalent molybdenum), or up to about 6% of copper, or both of these elements at one time.' The second claim varied these proportions by limiting silicon to .5% to 2% and nickel to 6% to 8%. Five alloys with specific stated proportions are also claimed in the patent. Of these four contain less than 1% of manganese. The only one of the specific **334 *53 alloys which contains copper also contains 4.76% of tungsten, and 1.31% of silicon.

The Commentary [FN1] (French) patent claimed a corrosive resistant alloy composed of 15% to 30% chromium; 2% to 12% nickel, 12% to 2% manganese, and 1AErbon, the sum of the percentages of nickel and manganese being between 8% and 20%. The inclusion of copper was stated in the specification in the following language:

FN1. This patent was granted to a company, but for convenience we refer to it as if granted to an individual.

'The resistance of these alloys to certain corrosives can be improved by additions of Cu and Mo together or separately, a content of 6% of each of these elements being, in general, sufficient; their nonoxidizability at a red heat, an equally interesting property, by an addition of Si, of which a content up to 3% will generally suffice.'

And in the resume (claims) it was said:

'This invention comprises:

'2. The addition to the alloy specified in (claim) (1) of the following elements, either in combination or separately:

a) of copper and of molybdenum, together or separately,

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each of these elements having a content going for example up to 6%.

b) of silicon of which the content may go for example up to 3%.

c) of known purging agents, such as aluminum, vanadium, titanium, zirconium.

'3. A variant of the alloy specified in 1 and 2, in which the nickel is totally or partially replaced by cobalt.'

Commentry gave no example of a specific alloy containing copper. He did, however, say that his alloy could be worked into tubes and wire-drawn filaments.

It will at once be seen that the specifications set forth in the appellant's claims 9, 10 and 11 fall within the ranges in the Hadfield (French) and Commentry (French) patents.

We think, however, that the Hadfield (French) patent does not anticipate the Becket application. The properties which Hadfield particularly asserted were increased resistance to oxidization and scaling, resistance to flame and hot products of combustion, and great mechanical strength at high temperatures. Nothing in the patent indicates that he was aware that alloys made within the ranges which he claimed would be stainless and deep-drawing. It is true that he describes his alloy as resistant to corrosion by air, water, and acids, but general corrosion resistance seems to be a quality not equivalent to stainlessness. For example, nickel resists many types of corrosion but tarnishes easily. Furthermore, the Hadfield (French) patent does not disclose a comprehension that copper was an essential element of the alloy. It will be noted that Hadfield said that copper could be included up to 6% in combination with from 1% to 10% of tungsten or molybdenum, or separately; but although he spoke of the use of copper separately, the only example containing copper also contained substantial percentage of tungsten. Thus, although he mentions a chromium-manganese-nickel-copper ferrous alloy, he gives no example of such an alloy, nor does he reveal that he ever actually made an alloy which contained copper in the absence of tungsten. And the specific examples show further that Hadfield was directing his attention primarily to a low-manganese alloy. [FN2] Silicon was evidently regarded as an essential part of the alloy. The Patent Office thought this immaterial, since all steel contains some silicon, and Becket had named the bulk of his alloy as 'substantially all iron.' The so-called 'residual silicon' present in practically all steel, however, is smaller in amount than the proportion Hadfield mentions. Steel containing over .5 silicon is considered an alloy, rather than common steel. Camp and Francis, op. cit. supra n. 2,758-59. The minimum of Hadfield's inclusion of silicon is .5%, the maximum 10%. We think it clear that Hadfield patented a chromium-**335

*54 manganese-nickel-silicon alloy, and that he made a chromium-manganese-nickel-silicon-copper-tungsten alloy. His mere mention of a chromium-manganese-nickel-copper alloy is not an anticipation of Becket. He was claiming a different sort of corrosion-resistant alloy, and merely added that his basic formula was 'able to contain some copper.' This was no more than a claim of the unexplored. It was common knowledge that even small amounts of copper aided steel's resistance to corrosion, and Hadfield indicated no more than this

FN2. The variance in the proportion of manganese in Becket's examples and those of Hadfield, and the latter's inclusion of tungsten, are the more significant because Hadfield is noted for his prior researches in the effects of manganese and tungsten upon steel. In a paper read before the British Iron & Steel Institute in 1888 he showed for the first time the utility of high manganese steels. In 1902-03 he exhaustively investigated the effects of tungsten alone upon steel, and these researches were reported in Hadfield, Alloys of Iron and Tungsten (1903) 11 Journal of the Iron and Steel Institute (British). See Camp and Francis, The Making, Shaping and Treating of Steel (4th ed. 1925).

The Commentry (French) patent has more force as a reference than has the Hadfield (French), since the former has some indication that the alloys described can be deep-drawn and there is a statement as to the sum of the percentages of nickel and manganese, just as there is in the Becket application. A careful reading of the patent, however, convinces us that so far as a chromium-manganese-nickel-copper alloy is concerned the inventor was but guessing in the dark. This type alloy is mentioned only as a variant of a chromium-nickel-manganese different results would be obtained, nor any indication that the metal would resist staining. He gives no illustration of the use of an alloy containing copper and merely suggest that it may be added to increase resistance to 'certain corrosives.' It seems clear that one seeking to find an alloy both stainless and deep-drawing would be led by the Commentry patent, if at all, into lengthy experimentation. Commentry suggested the addition molybdenum, silicon, cobalt, aluminum, vanadium, titanium and zirconium. A patent suggesting such a list of possible combining elements was held not an anticipation of a specific use of two of them in Haynes Stellite Co. v. Chesterfield, 6 Cir., 1927, 22 F.2d 635.

[1] Foreign patents are valid references when there is a clear disclosure of the invention sought to be patented in the United States. In re Cross, Cust. & Pat. App., 1932, 62 F.2d 182. But when such a patent merely prophesies what can be

(Cite as: 69 App.D.C. 51, 98 F.2d 332)

done without setting forth that it has been done, or makes claims for things not fairly disclosed in the specification, the foreign patent does not anticipate. Westinghouse Air-Brake Co. v. Great Northern Ry. Co., 2 Cir., 1898, 88 F. 258; General Electric Co. v. Hoskins Mfg. Co., 7 Cir., 1915, 224 F. 464; Haynes Stellite Co. v. Chesterfield, *supra*; American Stainless Steel Co. v. Ludlum Steel Co., 2 Cir., 1923, 290 F. 103. This court has said, in Davies v. Coe, 1936, 65 App.D.C. 345, 346, 83 F.2d 602, 603: 'The disclosure of a foreign patent is to be measured not by what may be made out of it, but what is clearly and definitely expressed in it. In re Ek, 57 App.D.C. 203, 19 F.(2d) 677; Carson v. American Smelting & Refining Co. (C.C.A.) 4 F.(2d) 463.' And in the Westinghouse Case the court held valid a United States patent for an air-brake, despite a prior English patent which stated: 'It is obvious that it (the stem of the emergency valve) might be worked as described by a separate piston in a cylindrical cavity communicating on the one side with the auxiliary reservoir, and on the other side with the train pipe.' In answering the contention that this described the valve set for the in the United States patent, and that therefore the latter lacked invention, the court said:

'The prophetical suggestions in English patents of what can be done, when no one has ever tested by actual and hard experience and under the stress of competition the truth of these suggestions, or the practical difficulties in the way of their accomplishment, or even whether the suggestions are feasible, do not carry conviction of the truth of these frequent and vague statements. The nature and character of the invention of 376,837 were, in the record heretofore before this court, put to rigorous tests by examination and cross-examination in court; and the result which was then reached is not shaken by merely a single sentence in the English patent.' (88 F. at page 263) Much the same thought is expressed in American Stainless Steel Co. v. Ludlum Steel Co., *supra*: ' . . . it requires more than prophecy of what may be done, or than declaration of what ought to be accomplished, to make a good patent reference, not to speak of an anticipation. It is necessary to show with reasonable certainty how the desired result can be accomplished.' (290 F. at page 106)

[2][3] We do not question that Hadfield and Commentary invented new and useful alloys, or that they state ranges which include the Becket discoveries. We think it was still possible, however, for an inventor to investigate subsequently and to find for **336 *55 the first time a chromium- manganese-nickel-copper ferrous alloy which was both stainless and deep-drawing. Though it be true that the alloy was found within ranges already known, it was an alloy of which both Hadfield and Commentary were unaware. With the Becket application before us it is possible to look back upon the Hadfield (French) and Commentary (French) patents and to say that they suggested what he

found, but such hindsight should not, we think, defeat his application. Hadfield and Commentary seem neither to have sought nor to have found an alloy which is both stainless and deep-drawing, and though it be true that the scope of their ranges embraces the claims of Becket, this speaks of the extent of their discoveries. In short, within previously claimed ranges Becket has found more restricted ones which produce a different alloy from that known to the prior inventors. One seeking a stainless deep-drawing alloy and finding the Hadfield (French) and Commentary (French) patents could not have said: 'These give me what I want.' [FN3] In the light of the decisions above cited as to the effect of foreign patents as anticipations, neither of the foreign references anticipated Becket.

[FN3] This is the test laid down in Skelly Oil Co. v. Universal Oil Products Co., 3 Cir., 1929, 31 F.2d 427, 431, where it is said:

' . . . Inferences as distinguished from disclosures, especially when drawn in the light of after events, cannot be accepted as a basis of anticipation.

'A patent relied upon as an anticipation must itself speak. Its specification must give in substance the same knowledge and the same directions as the specification of the patent in suit. Ott v. Linford, 46 L.T. (N.S.) 35, 44. It is not enough to prove that a method or apparatus described in an earlier specification can be made to produce this or that result. Flour Oxidizing Co. v. Carr & Co., 35 R.P.C. 457. A singularly sensible test of the rule of anticipation is given in British Thomson- Houston Co. v. Metropolitan Vickers Electrical Co., 45 R.P.C. 22, by asking the question-- 'Would a man who was grappling with the problem solved by the patent attacked, and having no knowledge of that patent, if he had had the alleged anticipation in his hand, have said: 'That gives me what I wish?' The Pope Alliance Corporation v. Spanish River Pulp & Paper Mills, Ltd. (Privy Council Appeals No. 33 of 1928.)'

[4] Patentability of an alloy upon the basis of new proportions of old elements requires that the new proportions give a new result; either a new alloy, or an old alloy with new characteristics which result in entirely new, or substantially enhanced, qualities of utility. Bethlehem Steel Co. v. Churchward International Steel Co., 3 Cir., 1920, 268 F. 361; Darwin & Milner, Inc. v. Kinite Corporation, 7 Cir., 1934, 72 F.2d 437; Pittsburgh Iron & Steel Foundries Co. v. Seaman-Sleeth Co., 3 Cir., 1918, 248 F. 705; Ex parte Crampton, 1934, 21 U.S.Pat.Q. 644. We think that the Becket alloys met this test. There is undisputed evidence in the record that prior to the Becket alloys the only commercially available stainless steel which could be deep-drawn was the so-called '18-8' (18%

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chromium and 8% nickel). Becket's steel is stainless and can be deep-drawn, and has novel proportions. It may fairly be said, therefore, that he has produced a new alloy with highly desirable qualities.

There is evidence that the proportions named by Becket are critical; in other words, that substantial departure from his proportions will result in failure to achieve the alloy of his invention. The Patent Office does not dispute the utility of the alloy and, as stated above, we are of the opinion that the Hadfield (French) and Commentary (French) patents do not anticipate Becket. The decision of the trial court is therefore, reversed as to claims 9, 10 and 11.

[5] We think that the decree of the trial court in rejecting claim 12 should be affirmed. This claim had been copied verbatim from the Armstrong patent, and was for

'A ferrous alloy characterized by its resistance to acid corrosion or intergranular corrosion, by its machineability and forgeability and its stable nonmagnetic condition comprising chromium about 18%, nickel about 8%, copper about 1.5% to 3%, manganese about 4% to 6%, carbon not substantially above about 0.15% and silicon less than 1%, the balance being substantially all iron.'

These specific proportions fall within the ranges which Becket had claimed, save in the case of copper, wherein his maximum the case of copper, wherein his maximum was 2.75%, rather than the 3% of claim 12. Nothing in Becket's specification dealt with the subject of intergranular corrosion, **337 *56 and the claim therefore asserts an attribute for the metal which the specification does not support. Further, neither in specification nor in proof has anything been advanced as to these particular proportions. We think the invention is sufficiently protected by claims 9, 10 and 11.

Reversed in part; affirmed in part.

END OF DOCUMENT

153 U.S.P.Q. 476
1967 WL 7641 (Pat. & Tr. Office Bd. App.)
(Cite as: 153 U.S.P.Q. 476)

Page 1

C

Ex parte Selby

Patent Office Board of Appeals

Patent issued May 2, 1967

Opinion dated Oct. 24, 1966

United States Patents Quarterly Headnotes

PATENTS

[1] Patentability - Composition of matter (§ 51.30)

Fact that percentages of applicant's claims fall within general proportions of reference does not completely preclude granting of patent; claims are allowed since claimed modification of reference's example coming closest to applicant's composition would not be obvious.

copolymerized methyl methacrylate, 27-33% by weight copolymerized 2-ethylhexyl acrylate, and 1.5-2.5% by weight copolymerized methacrylic acid, said interpolymer having an inherent viscosity of at least 0.4.

The references relied upon are:

Conn et al. 2,795,564 June 11, 1957

Straughan et al. 3,057,812 Oct. 9, 1962

Harren et al. 3,106,486 Oct. 8, 1963

Claims 1, 2, and 4 have been rejected under 35 U.S.C. 103 as obvious from the Straughan et al. patent, and the examiner has also referred to the Conn et al. and Harren et al. patents as showing certain features of the appealed claims.

We agree with the examiner that the Straughan et al. patent is a very pertinent reference, but we also agree with appellant that the record in the present case justifies the allowance of the limited claims here on appeal.

With respect to the components of appellant's composition, no argument is raised concerning the substitution of 2-ethylhexyl acrylate for the 2-ethylhexyl methacrylate of Example 39 of Straughan et al., and such argument would be difficult to sustain in view of the fact that the patent is replete with instances of the use of 2-ethylhexyl acrylate in similar relationships (Examples 30, 31, and 35, in particular). The argument concerning organic solution as against aqueous dispersion, not applicable to claims 1 and 4, is not convincing with respect to claim 2 because Straughan et al. suggest that their interpolymers may be made into a solution (column 9, lines 57 to 60).

[1] The only factor which remains to be considered is that of proportions of the several components. Here it must be acknowledged that the percentages of the appealed claims fall within the general proportions of the reference, namely, 25-90 parts, preferably 50-85 parts of methyl methacrylate; 10-60 parts of 2-ethylhexyl acrylate; and 1-10 parts, preferably 2-7 parts of methacrylic acid. However, this does not completely preclude the granting of a specific patent within the general percentage ranges of the reference.

As pointed out by the examiner, Example 39 of Straughan et al. comes closest to appellant's composition. However, in the reference composition the methyl methacrylate content is 3.5% too high, the 2-ethylhexyl methacrylate content is 8% too low, and the methacrylic acid content is 3.5% too high. Appellant's specification is indicative of the criticality of the claimed proportions (paragraph bridging pages 2 and

*476 Appeal from Group 140.

Application for patent of Richard N. Selby, Serial No. 321,446, filed Nov. 5, 1963. From decision rejecting claims 1, 2, and 4, applicant appeals (Appeal No. 657-14). Reversed.

Dennis L. Ryan, Wilmington, Del., for applicant.

Before Asp and Magil, Examiners in Chief, and Rebeld, Acting Examiner in Chief.

Magil, Examiner in Chief.

This is an appeal from the final rejection of claims 1, 2, and 4, the only remaining in the application.

Claim 1 is illustrative of the appealed claims and reads as follows:

1. An interpolymer of 65.5-71.5% by weight

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3; Examples 2, 3, and 4) and we are not satisfied that the claimed modification of Example 39 of Staughan et al. would be obvious within the meaning of 35 U.S.C. 103.

*477 The Conn et al. patent does indeed suggest a lower methacrylic acid content in a terpolymer with methyl methacrylate and 2-ethylhexyl acrylate (paragraph bridging columns 4 and 5 and particularly column 5, lines 11 and 12), and the Harren et al. patent likewise shows a lower methacrylic acid content, but even reducing the percentage of methacrylic acid in Example 39 of Staughan et al. would not result in the claimed composition.

[2] Appellant's reply brief is devoted to the examiner's refusal to admit into the record the second affidavit of commercial success under Rule 132. We will not consider this matter because it is not within our jurisdiction, and our decision is not based upon this second affidavit. Relief from the examiner's refusal to admit papers into the record must be by petition to the Commissioner, not by appeal to us.

The decision of the examiner is reversed.

Pat.Off. Bd.App.

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